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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/971,903	11/17/1997	HIROSHI HARUKI	826.1431/JDH	4920

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EXAMINER

MYHRE, JAMES W

ART UNIT PAPER NUMBER

3622

DATE MAILED: 03/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application

08/971,903

Applicant(s)

HARUKI ET AL.

Examiner

James W Myhre

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*[Handwritten signature]*

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 10 February 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 10-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Response to Request for Reconsideration*

1. A request for reconsideration was filed in this application after final rejection on February 10, 2004. Since the arguments presented were persuasive to overcome the rejection under 35 U.S.C. 102 in paragraph 4 of paper number 35, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. A new Office Action is presented below.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-8 and 10-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Todd et al (5,867,714) in view of Fawcett (5,845,077).

Claims 1, 10-13, 16, and 17: Todd discloses a system and method for registering and updating software on a remote computer, comprising:

a. User information general management means managing user registration information and status information by managing product information data

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and providing new or updated information in accordance with a request from a user (col 13, lines 45-49 and col 14, lines 25-35); and

b. User registration/reference means for notifying the general management means of the user registration and status information and for requesting new information about the product (col 12, lines 30-65);

c. Extracting information about the new or updated product from one of the remote databases and transmitting the information to the user (col 13, lines 16-28 and col 14, lines 25-35);

Todd further discloses tracking usage data (i.e. number of uses) and using the data to provide targeted suggestions/offers to the user (col 4, lines 31-41 and col 12, lines 30-65). Since these suggestions/offers are based on the type of information requested by the user during the registration step above, it is inherent that the targeted suggestions/offers are from vendors which sell products that may be of interest to the user.

While Todd does not explicitly disclose that the vendor receiving this information is a vendor other than the vendor (manufacturer/developer) of the software product being used by the user system, Fawcett discloses a similar system and method for monitoring and updating the software on a user system in which the tracking information is provided to a vendor server (update service center) which contains information about a wide variety of products to include "new computer software, new versions of existing computer software, new help files, etc." and "the availability of agent help files, wizards, inference engine, and other operating system components" (col 2, lines 30-45; col 5,

lines 29-47; and col 6, lines 17-32) and that this update service center may be connected to a remote network or remote sites to allow "the update service center to provide a wider variety of computer software than could be stored at the update service center" (col 5, lines 10-16). Thus, the update service center contains a wide variety of software files/products, not necessarily from the same software developer. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the tracking information in Todd to such a central update service center which contains software products and files from vendors other than the vendor which developed the software application currently being tracked on the user's system. One would have been motivated to present this information to such a vendor which carries software products from more than one software developer (vendor) in order to increase the range of targeted advertisements being presented by Todd, giving the user a more comprehensive choice of upgrades, help files, wizards, and new or replacement software products.

Claim 2: Todd and Fawcett disclose a system and method for registering and updating software on a remote computer as in Claim 1 above, and Todd further discloses means for the user to request new information about a product from the general management means (col 13, lines 45-49; col 14, lines 1-5; and col 14, lines 26-36).

Claim 3: Todd and Fawcett disclose a system and method for registering and updating software on a remote computer as in Claim 2 above, and Todd further discloses the registration process being built into the software and automatically

executed upon installation on the user's computer (col 6, lines 50-55 and col 11, lines 43-58).

Claim 4: Todd and Fawcett disclose a system and method for registering and updating software on a remote computer as in Claim 2 above, and Todd further discloses:

- a. A personal identification number as part of the registration information (col 13, lines 45-49 and col 14, lines 25-35); and
- b. The type of requested information which is extracted by the general management means and transmitted to the user (col 13, lines 47-49; col 14, lines 1-5; and col 14, lines 26-36).

Claims 5 and 6: Todd and Fawcett disclose a system and method for registering and updating software on a remote computer as in Claim 2 above, and Todd further discloses basing the automatic update of the software on the number of times the application had been accessed. Todd discloses a subscription-based service that analyzes license and maintenance agreements before updating the software (col 12, lines 58-65) and that usage data is being tracked (col 4, lines 31-34 and col 12, lines 30-65). This implies that the subscription is based on the usage of software (i.e. number of uses), probably also tied to a predetermined time period (i.e. 10 uses per month).

Claims 7, 8, 14, 15, and 18-20: Todd and Fawcett disclose a system and method for registering and updating software on a remote computer as in Claim 2 above, and Todd further discloses multiple vendors (remote data sources)(col 13, lines 16-28)

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updating the product information database of the general management means by providing new information pertaining to the type of product as requested by the user (col 12, lines 21-29 and col 12, lines 49-65). Todd discloses that the data is being revised on the remote data source which is part of a network of processing systems (col 13, lines 16-19) and contains a library of revisions (col 14, lines 18-20). Todd's further disclosure that the user may be able to actually purchase the update/new software from the remote data source (col 12, lines 53-57) and that at least one of the remote data servers could be a central data source (col 14, lines 41-46), implies that the central data source is being updated by the other remote data sources (i.e. vendor/manufacturer). Since the new information provided to the user is based on the type of product requested by the user during the registration step above, it is inherent that the vendor sells products which may be of interest to the user.

### ***Response to Arguments***

4. Applicant's arguments with respect to claims 1-8 and 10-20 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. James W. Myhre whose telephone number is (703) 308-7843. The examiner can normally be reached on weekdays from 6:30 a.m. to 3:30 p.m.

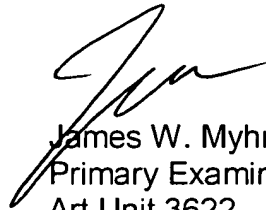
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, can be reached on (703) 305-8469. The fax phone number for Formal or Official faxes to Technology Center 3600 is (703) 872-9326. Draft or Informal faxes may be submitted to (703) 872-9327 or directly to the examiner at (703) 746-5544.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (703) 308-1113.



JWM  
March 10, 2004



James W. Myhre  
Primary Examiner  
Art Unit 3622